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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,725	01/11/2002	Gerald Tablada Caneba	1992.VIN	4004

7590

02/03/2005

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EXAMINER

ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 02/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,725

Applicant(s)

CANEBA ET AL.

Examiner

Tatyana Zalukaeva

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,8 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,8 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention

2. Claims 1 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation introduced by the present amendment "...the copolymer is formed without the addition of a capping agent" introduces new matter, because although the examples presented in the specification do not employ capping agents, such possibility is not excluded in the body of specification. The pages in specification, which Applicants refer to in support to this amendment (page 10, line 11 through page 11 , line 11) does not provide clear indication or suggest that the polymerization is performed without capping agent.

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Negative limitations which do not appear in the specification as originally filed, and which introduce **new concepts** violate the description requirement of 35 USC 112, first paragraph, **Ex parte Grasselli**, 231 USPQ 393 (Bd. App. 1983).

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-4, 8 are rejected under 35 U.S.C. 102 (e) as anticipated by or in the alternative under 35 U.S.C. 103 (a) as obvious 103(a) over Menzies Menzies discloses styrenic rubbers, which are **tapered block copolymers** (col.5, lines 1,2) as pressure sensitive adhesives. A preferred pressure sensitive adhesive is a copolymer of **isooctyl acrylate and acrylic acid in the ratio of 94/6 by weight**. (col.5, lines 20-25).

Therefore, Menzies anticipates the polymer, its nature relative monomer ratios, and characteristics of the instant claim 1.

With regard to the "free radical polymerization method", Menzies refers to RE 24,906 as for the method of polymerization and incorporates the entire disclosure of Re 24906 by reference. Re 24,906 provides only for free radical polymerization. There is no indication that the polymers of Menzies are obtained in the presence of capping agents. What is important that the copolymer of Menzies does contain 6% of acrylic acid, which is the data point within the claimed range.

The rejection of claim 8 is made in the sense of **Fitzgerald** (205 USPQ 594). (CAFC) based on presumption that the properties governing the claimed **copolymers** if not taught, may be very well met by the **copolymers of Menzies**, since the copolymers of

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Menzies are essentially the same as applicants' copolymers, and the burden to show that it is not the case is shifted to applicants; or in the sense of In re Spada, 911 F 2d 705, 709 15 USPQ 1655, 1658 (Fed. Cir. 1990), which settles that when the claimed compositions are not novel, they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in prior art.

5. Claims 1-4, 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menzies in view of Caneba et al (U.S. 5173,551).

In the event that one of the ordinary skill of the art will not immediately envisage the polymers of Menzies made as tapered by not using the capping agents, as instantly amended (note the "new matter rejection above"), then the rejection is made in view of Caneba.

In Caneba block copolymers produced using the ***free-radical retrograde precipitation polymerization methods*** to produce an unexpectedly high yield of narrow molecular weight distribution free-radical based polymers such as styrene (S), or those based on monomeric units such as methyl methacrylate (MMA), hydroxyethyl methacrylate (HEMA), vinyl chloride (VC), vinylidene chloride (VDC), butyl acrylate (BA), butylene (Bu), ethylene oxide (EO), ethylene (E), butadiene (B), isoprene (I), **vinyl acetate (VAc)**, vinyl alcohol (VOH), acrylonitrile (AN), acrylamide (AMD), vinyl butyral (VBL), **acrylic acid (AA)**, and mixtures thereof (paragraph bridging col.2 and 3). Preferred molecular weight of such polymers is 1000-100,000 (col.3, line 43).

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Since both Menzies and Caneba produce block (tapered) polymers without using a capping agent, and both achieve the content of hard copolymerizable monomer within the claimed range, it would have been obvious to those skilled in the art to utilize ***free-radical retrograde precipitation polymerization methods***, as taught by Caneba **for the same purpose** as Menzeis and thus to arrive the process that is used to produce the claimed product.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (571) 272-1115. The examiner can normally be reached on 9:00 - 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tatyana Zalukaeva
Primary Examiner
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A handwritten signature in black ink, appearing to read 'Zalukaeva', with a long, sweeping horizontal stroke extending to the right.

January 31, 2005